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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,939	11/21/2000	Jay C. Hsu	KCX-360 (15633)	9825

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EXAMINER

JOYNES, ROBERT M

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 06/28/2002 8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,939

Applicant(s)

HSU ET AL.

Examiner

Robert M. Joynes

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1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12-26, 28-38 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) 1, 11, 27 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10, 12-26, 28-38 and 40-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of applicants' Information Disclosure Statement filed on March 25, 2002 and Amendment filed on April 8, 2002.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 6, 7, 10, 14, 15, 45, 48 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Krzysik (US 5869075). Krzysik teaches a tissue product that has been treated with a lotion composition (Col. 1, lines 41-58). The lotion composition comprises water (Col. 3, lines 1-15), polyethylene glycol (Col. 3, lines 16-27), a fatty alcohol (Col. 3, lines 28-34), an emollients (Col. 4, lines 13-24), an emulsifier (Col. 4, lines 13-24) as well as other ingredients for skin care (Col. 3, line 35 – Col. 4, line 10). The lotion composition adds about 0.5% to about 40% weight percent to the paper product (Col. 4, lines 26-39). The paper products the lotion is applied to are facial tissue, bath tissue, paper towels, dinner napkins and the like (Col. 4, lines 46-57).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 7, 10, 14, 15, 45, 48 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik. The teachings of Krzysik are discussed above. Krzysik does not expressly teach the exact ranges of the ingredients of the lotion composition.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to vary the amounts of ingredients in a lotion composition.

While the reference does not teach the complete concentration range, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

One of ordinary skill in the art would have been motivated to do this to prepare lotion compositions with additional ingredients that achieve the same or similar expected results.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 4, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik in view of Luu et al. (US 5871763). The teachings of Krzysik are discussed above. Krzysik does not expressly teach the emollient to be C<sub>12</sub> - C<sub>15</sub> alkyl benzoate.

Luu teaches that suitable emollients for a lotion composition are silicones, phospholipids, oils (synthetic and natural) and benzoate ester emollients (C<sub>12</sub> - C<sub>15</sub> alkyl benzoate) (Col. 7, line 33 – Col. 8, line 62).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute one emollient in a lotion composition for another suitable emollient.

One of ordinary skill in the art would have been motivated to do this prepare lotion compositions with emollients that provide differing properties (i.e., emollients that lubricate or moisturize the skin as opposed to those that retard moisture loss or maintain the skin moisture/vapor balance (Luu, Col. 7, lines 33-40).

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik in view of Mackey et al (US 5624676). The teachings of Krzysik are discussed above. Krzysik does not expressly teach that the emulsifier is polyoxyethylene stearyl ether or a steareth.

Mackey teaches that steareth compounds are known emulsifiers (Col. 21, lines 3-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute any emulsifier for another suitable emulsifier, namely a steareth compound.

One of ordinary skill in the art would have been motivated to do this to prepare a lotion composition with an emulsifier that is suitable for different emollients and stabilizer agents.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik in view of Wagner et al. (US 5948416). Krzysik does not expressly teach that the humectant used is glycerin. Krzysik also does not expressly teach that the humectant is present in the lotion in amount between about 10% and 40%.

Wagner teaches a lotion composition that contains a humectant in amounts from about 0.1% to about 20% (Col. 12, lines 50-59). Wagner further teaches the humectant to be glycerin (Col. 13, lines 13-25).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik in view of Blieszner et al. (US 5648083). The teachings of Krzysik are discussed above. Krzysik does not expressly teach that the skin conditioning agent to be dimethicone.

Blieszner teaches dimethicone as a skin care compound used as a barrier agent (Col 4, lines 36-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate a skin care compound such as dimethicone into a lotion composition.

One of ordinary skill in the art would have been motivated to do this prepare a lotion that provides lubrication for the skin.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 16-44, 46, 47 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krzysik in view of Wagner, further in view of Luu, further in view of Blieszner furthering view of Warner et al. (US 5716692). The teachings of Krzysik, Wagner, Luu and Blieszner are all discussed above. Krzysik, Wagner, Luu and Blieszner do not expressly teach the type of paper that the lotion must be incorporated on or the various methods of incorporating the lotion onto the paper.

Warner teaches a lotion composition that imparts a soft, lubricious, lotion like feel when applied to paper (Col. 3, lines 39-59). Warner further discusses the different paper that can be used for the invention (Col. 4, line 27 – Col. 8, line 33). Still further, Warner teaches the different way the paper can be treated with the lotion (Col. 16, line 32 – Col. 18, line 53).

Krzysik teaches the basic paper product treated with a lotion composition. Luu teaches the emollient to be C<sub>12</sub> - C<sub>15</sub> alkyl benzoate. Mackey teaches the emulsifier to be a steareth compound. Wagner teaches the humectant to be glycerin. Blieszner teaches the skin care agent to be dimethicone. Warner teaches how to treat the paper with the lotion.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to prepare a lotion composition comprising water, an emollient, an emulsifier, a fatty alcohol, a skin conditioning agent and additional ingredient (an antimicrobial or a preservative) that would be suitable to treat a paper product.

One of ordinary skill in the art would have been motivated to do this to prepare a product that cleans the skin effectively while providing comfort by lubricating or moisturizing the skin.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicants' arguments filed April 8, 2002 have been fully considered but they are not persuasive. Applicants' argue that the particular selection and concentration ranges of the ingredients utilized in the lotion of the instant claims can provide a synergistic effect when applied to a paper product. Further, applicants argue that they have discovered that when lotion is applied to the paper product at low add-on levels the resulting product can remain absorbent while simultaneously imparting certain benefits to the skin.

The Examiner would first like to direct applicants' attention to Column 4, lines 26-32 of the Krzysik reference. The reference teaches that the total tissue add-on of the composition (lotion) can be from about 0.5 to about 40 weight percent, more specifically from about 5 to about 30 weight percent, and more specifically from about 10 to about 15 weight percent. This range for the add-on level completely encompasses the range claimed in the instant application and even specifically claims a lower and smaller range. The reference further states the add-on amount will depend upon the desired effect of the composition on the product attributes and the specific composition. From this, it would have been obvious to one of ordinary skill in the art to provide a tissue



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product in which the add-on levels are from 1 to 15 weight percent, as is presently claimed.

The applicants argue that they have discovered a synergistic effect with the specific ingredients and at specific concentration ranges of the instant application when applied to a paper product. After examining the specification, the Examiner fails to find evidence of such a synergistic effect. Applicants provide no data showing this alleged synergistic effect. Applicants show data relating to a treated paper product and an untreated paper product. This does not prove the synergistic effect on the particular combination of ingredients when applied to a paper product. It shows that a certain benefit is achieved when compared to an untreated product. This synergism is already known in the art as is evidenced by the Krzysik reference, which teaches a paper product that is combined with a lotion. Applicants have not shown that the particular ingredients at the particular concentrations provide some unexpected result or synergistic effect when applied to paper products. Absent a showing of such, the prior rejections are maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (703) 308-8869. The examiner can normally be reached on Monday through Friday 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Robert M. Joynes  
Patent Examiner  
Art Unit 1615  
June 26, 2002

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